Supreme Court, U.S.
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No. 98-1719

IN THE

Supreme Court of the United States

THOMSON S.A.,

Petitioner,

v.

QUIXOTE CORPORATION and
DISC MANUFACTURING, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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COUNTERSTATEMENT OF QUESTIONS PRESENTED

1. Whether this Court should grant a petition for certiorari to review a decision of the Federal Circuit allegedly in conflict with an earlier opinion of that Court, where the Petitioner did not request a rehearing en banc below and where, in rendering the later decision, the Federal Circuit expressly considered and correctly distinguished its earlier opinion.

2. Whether this Court should grant a petition for certiorari to review the Federal Circuit's decision not to extend that Circuit's rule requiring corroboration of testimony from an interested inventor in patent cases to a case involving disinterested non-party witnesses who were not, in any event, inventors.

STATEMENT PURSUANT TO RULE 29.6

Respondent Quixote Corporation has no parent companies but is the parent company of Respondent Disc Manufacturing, Inc.

There are no publicly held companies that own 10% or more of the stock of either corporate respondent.

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INTRODUCTION

Nothing in this case compels this Court's discretionary intervention. It presents no inter-circuit conflict or a conflict with any decision of this Court. Nor is the decision below, on a matter peculiarly within the Federal Circuit's expertise, in conflict with any Federal Circuit authority or otherwise of such importance as to merit the extraordinary grant of certiorari. And contrary to Petitioner's exaggerated claims, the patent system is not on the verge of collapse as a result of the decision below.

The petition in this case relates to the exact boundaries of a rule of evidence specific to patent cases: the corroboration rule applied by the Federal Circuit in examining the adequacy of evidence supporting a finding of patent invalidity due to prior invention by another, pursuant to 35 U.S.C. § 102(g). This rule relates to the assessment of the credibility of an inventor's testimony, and requires corroboration of the testimony of an interested inventor. Petitioner contends, contrary to the holding of the Federal Circuit below, that there should be a mandatory requirement that *all* testimony as to prior invention be corroborated, even where the witness is a disinterested non-party to the litigation.

Petitioner's main argument, that the holding below creates an unjustified exception to a long-standing rule of importance to our "first to invent" patent system, is unavailing. As the opinion below makes clear, there is no such long-standing rule: neither the Supreme Court nor the Federal Circuit has applied the mandatory corroboration rule for inventor testimony to the situation here, where the witnesses were disinterested non-parties. Thus, no rule has been overturned or done away with, nor has a special

exception been carved out; the Federal Circuit has simply declined to extend its present rule, applicable only to inventors, to the new circumstances presented by this case of first impression. This case involves the apparently rare situation where the testifying witnesses were not parties, not inventors, and were not interested in the outcome. The patent system has not been placed in dire jeopardy by this non-extension of the existing rule.

Petitioner's second argument, that the holding is inconsistent with the Federal Circuit's recent decision in *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368 (Fed. Cir. 1998), is equally unavailing. The Federal Circuit panel perceived no clash, noting and carefully distinguishing *Woodland Trust* without dissent. Petitioner did not request en banc review, the proper initial procedure for resolving intra-circuit conflicts, to correct the alleged inconsistency. Nor did a majority of the active members of the Federal Circuit perceive any inconsistency in the panel decision, for they did not order sua sponte a hearing en banc under Federal Circuit Rule 35(a).

Finally, Petitioner's request should be denied because the issue Petitioner attempts to raise is unsupported by the facts of this case. In short, Petitioner urges this Court to extend the corroboration rule to *all* inventors, disinterested or not. Even if this Court were to extend the existing rule to all inventors, the new rule would be inapplicable here because it is "undisputed" (as the District Court noted) that Respondents' witnesses were *not* inventors. The Federal Circuit chose, for the purposes of argument, to assume the opposite in order to demonstrate to Petitioner that *even with the benefit of that assumption* (among others), Petitioner could not win. Petitioner's hypothetical argument does not

warrant this Court's review. Petitioner's further suggestion of an even broader rule, requiring "contemporaneous physical corroboration" for *all* prior invention, is a proposal unsupported by the prevailing law of this Court or the Federal Circuit, including *Woodland Trust*.

The petition should be denied.

COUNTERSTATEMENT OF THE CASE

A. The Proceedings In The District Court

The facts of the case are set out in detail in the memorandum opinion of District Judge Longobardi denying Petitioner's post-trial motion for judgment as a matter of law and new trial (Br. 17a-55a).[1] However, it is necessary to review the proceedings below to correct certain inaccurate assertions of fact made by Petitioner.

The jury found each of Petitioner's patents invalid under 35 U.S.C. § 102(g) as being anticipated by MCA's prior work on videodiscs.

As the record reveals, MCA's work was not "secret prior art" or the "private thoughts" of an inventor as Petitioner repeatedly asserts. The videodisc developed by MCA in 1972 was disclosed to numerous employees such as Richard Wilkinson and Larry Canino, both of whom testified at trial, and to company executives. The disc was later publicized and developed into a commercial product known today as the laserdisc (A884-85, 866-67, 1020). Petitioner stipulated that its own videodisc researchers were

1. Cited portions of the parties' Joint Appendix submitted to the Federal Circuit are cited as "A__." Cited portions of the Petition for Writ of Certiorari and its Appendix are cited as "Br. __."

aware of the 1972 demonstrations of the MCA disc (A4082), and admitted that three of its senior technical executives attended the December 1972 demonstration at MCA (A745-47).

At trial, Petitioner claimed victory in a technical race, sparked by the invention of the laser in the 1960s, to invent optical storage disks for video (A129-30). But the evidence — uncontroverted by any witness for Petitioner — established that the real victor of the race to develop the videodisc was MCA, not Petitioner. Indeed, in June and December 1972, when MCA successfully demonstrated a full-color videodisc, Petitioner was unable even to display a black and white still picture with its own videodisc technology (A246-47).[2]

Petitioner filed its patent application in August 1972, two months after the successful MCA demonstration in June 1972. Petitioner filed its application after it learned that MCA had already conducted a successful demonstration to its executives and was planning further demonstrations (A324-33).

MCA's prior work was established by the evidence of three witnesses, Messrs. Wilkinson, Canino and Slaten, supported by documentary evidence.[3] None of the three

2. Petitioner did *not* invent the CD, contrary to the suggestions in the petition. Instead, the development of the CD is credited to Philips Electronics and Sony Corporation. Petitioner never even developed a commercially successful videodisc product. Further, the patent licensing activities relied upon in the petition were excluded by the District Court as irrelevant (A98-102).

3. Petitioner's argument that the Federal Circuit relied upon the testimony of only one witness, Wilkinson, is flatly contradicted by the Federal Circuit's opinion which relied on both Wilkinson and Canino (e.g., Br. 8a).

witnesses was an inventor of the MCA disc. Wilkinson was an employee of MCA who worked on the preparation of optical discs (A823-24). He testified in detail as to the features of the discs and the method by which they worked. He witnessed a successful demonstration of the disc for high-ranking company executives in June 1972 (A868-75). He also identified prototype players resembling those used to play the discs in 1972 and MCA players that were commercially sold for some years, including to government institutions and M.I.T. (A862-68).

Canino, also an MCA employee at the time of the 1972 demonstrations, had personal knowledge of the MCA disc through, inter alia, studying it under a microscope at the time (A1018-19). He also testified in detail as to the structure and format of the MCA disc.[4] Canino witnessed the June 1972 demonstration (A1001-07) and was a key figure in a December 1972 demonstration at which the MCA disc was revealed to a wider public, including entertainment industry figures and other guests such as the head of Petitioner's research laboratory and two other senior technical executives of Petitioner (A745-47). Canino also participated in numerous public demonstrations that occurred after the December 1972 demonstration (A884-85, 1020).

Neither Wilkinson nor Canino was an inventor of the MCA disc; indeed, the District Court considered this fact to be "undisputed" (Br. 50a). Neither was an employee or otherwise associated with Respondents, who were the

4. Petitioner creates the impression that Canino's testimony was stricken from the record. In total, only a few answers were stricken and, indeed, Judge Longobardi extensively relied upon Canino's testimony (e.g., Br. 24a).

defendants below. As the Federal Circuit correctly concluded, they were disinterested non-party witnesses (Br. 12a).

Gary Slaten joined MCA as an employee in 1973. His expert report, which was read into the record, relied upon extensive documentary evidence such as MCA research reports, patents and specification sheets.[5] It also relied upon an electron microscope photograph of an MCA disc and Slaten's personal knowledge of the discs, acquired during his time at MCA.[6]

In addition, Respondents introduced into evidence numerous MCA documents, including those relied upon by Slaten.[7] For example, the MCA disc was also described in a contemporaneous MCA patent filing on its player technology and in a fact sheet from the December 1972 demonstration (A3278, 4113).[8]

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5. Petitioner's assertion that Slaten's testimony was conclusory and/or unsupported ignores the wealth of documentary and physical evidence supporting it (A3319-3612, 3829-3998).

6. Wilkinson confirmed that the format of the discs was the same in 1973 (when Slaten joined MCA) as in 1972, and indeed remained the same until about 1976 (A848-49, 891, 948).

7. Petitioner's repeated statement that no supporting physical or documentary evidence exists is a fantasy. And Petitioner's dark suggestion that some evidence was "inexplicably missing" is unjustified; there was no evidence whatsoever of spoliation.

8. These exhibits also contradict Petitioner's erroneous statement that no structural details of MCA's disc were disclosed until April 1974 (Br. 17).

In contrast, Petitioner chose to present no testimonial evidence in rebuttal to the MCA prior art defense, not even by its technical expert.

B. The Federal Circuit Opinion

The Federal Circuit, per Judge Rich, unanimously rejected Petitioner's argument that there was insufficient evidence to support the verdict of invalidity. In particular, the Federal Circuit concluded that, even if the Court were to assume: (1) that Wilkinson and Canino were inventors, *and* (2) that there was no other evidence in the case, Petitioner still would not win. The Federal Circuit based its decision on the fact that corroboration of *disinterested* non-party inventor testimony in infringement cases is not required as a matter of law, unlike the testimony of interested inventors.

The Federal Circuit viewed the issue as one of first impression:

> Although courts have reviewed infringement suits in which the defendant had attempted to prove subsection 102(g)-type anticipation by a non-party inventor at trial, neither the Supreme Court nor we have directly held whether the corroboration rule must be applied to testimony by non-party inventors that is directed to establishing their invention as anticipating the claims in issue.

(Br. 10a; citations omitted). The Federal Circuit concluded that the corroboration rule is directed to situations in which the testifying witness is an inventor who is self-interested in the outcome of the trial.[9] Hence, the Court held that the corroboration rule extended only to cases:

9. This occurs most frequently in interference proceedings, where the inventors are parties competing for patent rights and thus necessarily "interested" in the outcome.

> when the testifying inventor is asserting a claim of derivation or priority of his or her invention and is a named party, an employee or assignor to a named party, or otherwise is in a position where he or she stands to directly and substantially gain by his or her invention being found to have priority over the patent claims at issue.

(Br. 12a). The Federal Circuit held that substantial evidence existed to support the jury's verdict of invalidity.

REASONS FOR DENYING THE WRIT

I.

NONE OF THE TRADITIONAL BASES FOR GRANTING CERTIORARI ARE PRESENT IN THIS CASE.

There is no conflict between the Circuits or with any prior decisions of this Court. Furthermore, the subject matter of this petition is a specialized corroboration rule peculiar to patent cases that does not relate to substantive standards of patentability. The special competence of the Federal Circuit in this area, and the ability of the Federal Circuit to resolve any supposed inconsistency with its prior rulings without intervention by this Court, render the arguments presented by Petitioner insufficient to justify granting certiorari.

II.

CERTIORARI IS NOT APPROPRIATE TO RESOLVE ANY INTRA-CIRCUIT CONFLICT.

There is no authority for Petitioner's argument that this Court's practice of granting certiorari to resolve inter-circuit conflicts "is equally applicable to resolving irreconcilable conflicts between two Federal Circuit decisions on patent matters" (Br. 23). To the contrary, as Justice Harlan once noted:[10]

> decisions between different panels of the same Court of Appeals will not be considered to present a reviewable conflict, since such differences of view are deemed an intramural matter to be resolved by the Court of Appeals itself.

The Federal Circuit has established its own procedures for resolving any alleged conflicts. Petitioner chose not to avail itself of those procedures. Any alleged conflict between two Federal Circuit decisions should have been resolved by a request for reconsideration or a suggestion for en banc review — neither of which was sought by Petitioner. Moreover, under Fed. Cir. R. 35(a), a majority of the active members of the Court could have initiated rehearing en banc if there were a perceived conflict with other decisions of the Court.

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10. The Honorable John M. Harlan, "Manning the Dikes," 13 Record of the Ass'n of the Bar of the City of New York 541, 552 (1958), *quoted in* ROBERT L. STERN, ET AL., SUPREME COURT PRACTICE, 176 (7th ed. 1993).

III.

THE DECISION BELOW IS CONSISTENT WITH *WOODLAND TRUST.*

In *Woodland Trust,* the defendant claimed to be a prior inventor. Accordingly, the Federal Circuit required the prior inventor's testimony to be corroborated. The only corroborating testimony defendant put forward was that of "interested persons and their friends." The Federal Circuit held that, in light of all the circumstances, there was inadequate corroboration of the inventor's testimony to satisfy the "clear and convincing" standard of proof. 148 F.3d at 1371, 1373.

Thus, the *Woodland Trust* Court premised its holding on the interested nature of the witnesses, holding that "there is a very heavy burden to be met by one challenging validity when the only evidence is the oral testimony of *interested persons and their friends*, particularly as to long-past events." 148 F.3d at 1371 (emphasis added). The Court particularly noted the "relationship of the witnesses," and "the temptation to remember facts favorable to the cause of one's *relative or friend*." *Id.* at 1373 (emphasis added).

The holding of *Woodland Trust* is fully consistent with the present case. In *Woodland Trust*, the Federal Circuit held that the defendant/inventor's testimony needed to be corroborated, and was not adequately corroborated by interested witnesses. Neither Wilkinson nor Canino was an inventor, neither was a party, and

neither was interested in the outcome.[11] Their testimony does not require corroboration under *Woodland Trust*.[12]

Recognizing that the *holdings* in the present case and *Woodland Trust* are fully consistent, Petitioner instead attempts to take issue with the *facts* of *Woodland Trust*, alleging that one corroborating witness, Hudson, was in fact "disinterested." Petitioner's argument is flatly contradicted by *Woodland Trust*, which characterizes all the corroborating testimony as that of "interested persons and their friends." Nor is Petitioner's argument to the point: no challenge to *Woodland Trust* is properly before this Court.

It is not surprising that there is no inconsistency between the two cases. *Woodland Trust* was decided (and a suggestion for en banc rehearing was declined by the Court) when the appeal below was sub judice. The opinion below distinguished *Woodland Trust* without dissent, and provoked no suggestion for en banc review, either sua sponte or from Petitioner, to reconcile the two cases. Petitioner's misguided attempt to revisit the underlying facts of *Woodland Trust* merely underscores the lack of any merit to its case.

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11. Petitioner's argument that *Woodland Trust* "uphold[s] the corroboration rule for third party witnesses," is mistaken (Br. 13). Nowhere in *Woodland Trust* does the Federal Circuit state such a rule, which would contradict the well-established principle that the corroboration rule applies only to inventors. *Holmwood v. Sugavanam*, 948 F.2d 1236, 1239 (Fed. Cir. 1991); *Borror v. Herz*, 666 F.2d 569, 572-73 (C.C.P.A. 1981).

12. Even if it did, there was in fact ample corroboration of the testimony of Wilkinson and Canino by each other, and in the testimony of Slaten and the documentary and physical exhibits, all of which were cited and relied upon by the District Court (e.g., Br. 39a).

IV.

THE FEDERAL CIRCUIT HAS NOT DEPARTED FROM ANY LONG-ESTABLISHED RULE.

If a corroboration rule *applied to non-party inventors* had truly been a bulwark of the United States patent system for over a hundred years, as Petitioner claims, then one would expect to find it in the case law. But Petitioner has not cited a single case in which a Court has applied the mandatory corroboration rule to the testimony of a disinterested non-party inventor. Nor was the Federal Circuit cognizant of any such authority, treating this as a case of first impression. The ruling below does not overturn any pre-existing rule; it merely declines to change the law by extending the corroboration rule to a new arena. In short, there is no authority for Petitioner's argument that all testimony about "prior inventive activity" must be corroborated (Br. 19).

V.

THERE WERE MORE THAN ADEQUATE SAFEGUARDS WITHOUT APPLYING THE MANDATORY CORROBORATION RULE.

Petitioner fails to distinguish clearly between two distinct and separate safeguards to patent validity, namely, the high burden of proof (clear and convincing evidence) for invalidity and the corroboration rule. Concerns about the strength of oral testimony have led this Court to impose a high standard of proof. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 60 (1923). The rule requiring mandatory corroboration of an inventor's

testimony is a further safeguard above and beyond the required standard of proof. *See Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993).

By refusing to extend the corroboration rule to disinterested non-party inventors, the Federal Circuit has not removed the safeguards provided by this Court and opened up patents to "sudden" invalidity attacks on the basis of unreliable oral testimony as to "secret prior art." To the contrary, the Federal Circuit explicitly pointed to the high standard of proof as a safeguard that makes extension of the corroboration rule unnecessary where no self-interest is shown (Br. 11a-12a).[13]

As with any other litigant, Petitioner was protected during discovery and trial by the Federal Rules of Evidence, the Federal Rules of Civil Procedure and the high burden of proof (Br. 11a-12a). Petitioner cross-examined Respondents' witnesses in detail and had the opportunity to present expert and other evidence in rebuttal (which it chose not to do). The jury was properly instructed as to the high standard of proof which Respondents were required to meet. There was no miscarriage of justice in the decision below.

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13. In *Washburn & Moen Mfg. v. Beat 'Em All Barbed-Wire Co.*, 143 U.S. 275, 284 (1892), quoted by Petitioner (Br. 18) and discussed by the Federal Circuit in the opinion below (Br. 11a), the evidence of a prior use was held insufficient to meet the high burden of proof. 143 U.S. at 284. The Court did not impose a mandatory corroboration rule in *Washburn*.

VI.

PETITIONER GIVES INCORRECT STATEMENTS OF THE CORROBORATION RULE.

The corroboration rule has only been imposed upon inventors and does not apply to all testimony of "prior inventive activity", as Petitioner sometimes suggests. *Holmwood*, 948 F.2d at 1239; *Borror*, 666 F.2d at 572-73. Nor does the rule require that corroborating evidence consist of contemporaneous documents. *E.g.*, *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1461 (Fed. Cir. 1998).[14] Petitioner's claim that the Federal Circuit has breached these supposedly long-standing doctrines is thus erroneous; there is no clash of principle that this Court is required to resolve, nor need this Court intervene to micro-manage the Federal Circuit's application of the corroboration rule.

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14. Petitioner's authorities are not to the contrary, expressing only reservation as to the quality of oral testimony in certain circumstances — namely, where there are interested parties and inventors. In *Lockheed Aircraft Corp. v. United States*, 553 F.2d 69, 75 (Ct. Cl. 1977), the prior inventors and corroborating witness were all employees of the defendant. *Deering v. Winona Harvester Works*, 155 U.S. 286 (1894), cited by Petitioner at Br. 19, demonstrates the imposition of a high standard of proof, not a rigid requirement of mandatory contemporaneous corroboration. 155 U.S. at 300-01. Such a requirement would fly in the face of the Federal Circuit's rule of reason, which assesses corroboration flexibly in all the circumstances of the case. *Price*, 988 F.2d at 1195.

VII.

THERE IS NO ANOMALY OR UNFAIRNESS RESULTING FROM THE RULE APPLIED BY THE FEDERAL CIRCUIT.

Petitioner suggests that an anomaly is created when the testimony of an inventor who is not an interested party may be sufficient to invalidate a patent in one case, yet insufficient in another case where the inventor is an interested party (Br. 25-26). There is no anomaly. The corroboration rule in patent cases, as in other areas of the law, is specifically designed to counter-balance the interest of a witness in a particular case, and should not apply in other cases where the witness does not have an interest.[15]

Moreover, Petitioner's complaint over the time lapse between the MCA invention in 1972 and the trial in 1996 is unjustified, as the delay was caused by Petitioner's protracted prosecution of its "submarine" patents, filed in 1972 and not issuing until 1989 and 1993. Fortunately, amendments by Congress to the patent laws prompted by public concern over "submarine" patents ensure that this situation will not arise again.[16]

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15. *See*, for instance, *Cool v. United States*, 409 U.S. 100, 103 (1972), recognizing the frailty of testimony given by an accomplice at the trial of criminal defendant, due to the accomplice's special interest in testifying.

16. 5 DONALD S. CHISUM, CHISUM ON PATENTS § 16.04[1] at 16-189 (1998) (20-year-from-filing patent term prompted by concern over submarine patents).

VIII.

PETITIONER'S ARGUMENT IS HYPOTHETICAL AND DOES NOT PROPERLY ARISE ON THE FACTS OF THIS CASE.

It was "undisputed" that Wilkinson and Canino were not inventors and therefore not subject to the Federal Circuit's mandatory corroboration rule in the first place (Br. 50a). The Federal Circuit was willing to assume that the witnesses were inventors for the purposes of argument, in order to demonstrate that Petitioner's arguments still failed under that assumption (Br. 7a-8a).

In any event, it is clear that the undisputed facts of this case cannot support Petitioner's argument. That makes the argument hypothetical and, therefore, unsuitable for the Court's review.

CONCLUSION

Respondents respectfully submit that there is no ground upon which this Court should exercise its discretion to intervene, and that therefore the petition for certiorari should be denied.

Respectfully submitted,

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APPENDIX

APPENDIX — FEDERAL CIRCUIT RULE 35(a)

FEDERAL CIRCUIT Rule 35. En Banc Determination

(a) General.

(1) **Decision to Review En Banc.** A case will be reviewed en banc if a majority of the judges in regular active service agree to hear it en banc. Judges who are recused or disqualified from participating in the case are counted as judges in regular active service.

(2) **Arguing to a Panel to Overrule a Precedent.** Although only the court en banc may overrule a binding precedent, a party may argue, in its brief and oral argument, to overrule a binding precedent without petitioning for hearing en banc. The panel will decide whether to ask the regular active judges to consider hearing the case en banc.

(3) **Frivolous Petition.** A petition for hearing or rehearing en banc that does not meet the standards of Federal Rule of Appellate Procedure 35(a) may be deemed frivolous and subject to sanctions.

* * *